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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Bjorn Bunte

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11/06/2009

DITTHAVONG MORI & STEINER, P.C.

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EXAMINER

DOAN, TRANG T

ART UNIT

PAPER NUMBER

2431

NOTIFICATION DATE

DELIVERY MODE

11/06/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docket@dcpatent.com

Office Action Summary	Application No. 10/591,368	Applicant(s) BUNTE ET AL.	
	Examiner TRANG DOAN	Art Unit 2431	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51-88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51-88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/31/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-50 have been canceled.
2. Claims 51-87 are pending for consideration.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

4. The information disclosure statement (IDS) submitted on 08/31/2006 is being considered by the examiner.

Specification

5. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Claim Objections

6. Claims 52-88 are objected to because of the following informalities:
7. Regarding claims 52-67, the limitation "A computer system" should be changed to "The computer system".

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8. In addition to claim 52, the limitation “an authenticated source, and the verification information” should be changed to “an authenticated source and the verification information”.
9. Regarding claim 68, the limitation “a method of operating a computer system according to claim 51” should be changed to “The computer system according to claim 51”.
10. Regarding claim 69, the limitation "providing electronic, displayable verification information" should be changed to "providing electronic displayable verification information ".
11. Regarding claims 70-87, the limitation “A method according to” should be changed to “The method according to”.
12. Regarding claim 88, the limitation “electronic, displayable verification information” should be changed to “electronic displayable verification information”.
13. Appropriate correction is required.

Claim Rejections - 35 USC § 112

14. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

15. Claims 51-88 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to

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one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. **Examiner notes that nowhere in the specification is disclosed “a memory configured to store electronic image data corresponding to an original document having a verifiable provenance, and separately derived electronic displayable verification information corresponding to the provenance of at least part of the original document, and an output configured to provide said image data and said verification information for display by the user to authenticate the original document”, “the provenance that has been subjected to authentication by the repository, and the verification information being configured to signal to the user that the repository provides such authentication”, “wherein the repository agent is operable to send the image data together with source authentication information to indicate to the repository that the image data has been sent from the agent”, “wherein the verification information comprises accreditation data to be viewed by a user in a separate field associated with the image data for authenticating the original document”, “a server providing said memory and operable to host a website at which said image data and verification information is viewable by a user to authenticate the original document”, “wherein the image data and the verification information corresponding to the original document when stored in the memory collectively has an individual addressable identity”, and “wherein said image data and verification information in the memory is password protected so that the user can only gain access thereto by use of the password” as recited in claims 51-88.**

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16. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

17. Claims 51 and 69 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

18. Claims 51 and 69 recite the limitation "said verification information/the verification information". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

19. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

20. Claim 88 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim is directed to an electrical signal for displaying a document for authentication. The electrical signal does not fall within one of the four statutory classes of an invention (method/process, article of manufacture, a composition of matter, or machine).

Claim Rejections - 35 USC § 102

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

22. Claims 51-88 are rejected under 35 U.S.C. 102(e) as being anticipated by Eden (US 20030145200) (hereinafter Eden).

23. Regarding claim 51, Eden discloses a computer system accessible remotely by a user to authenticate a document, comprising: a memory configured to store electronic image data corresponding to an original document having a verifiable provenance, and separately derived electronic displayable verification information corresponding to the provenance of at least part of the original document, and an output configured to provide said image data and said verification information for display by the user to authenticate the original document (Eden: paragraphs 0028 and 0030).

24. Regarding claim 52, Eden further discloses wherein the image data has been obtained from an authenticated source and the verification information includes data corresponding to the provenance of the authenticated source (Eden: paragraph 0033).

25. Regarding claim 53, Eden further discloses wherein data is fed to and from the memory under the control of a repository (Eden: paragraph 0029).

26. Regarding claim 54, Eden further discloses wherein the verification information comprises data concerning the provenance that has been subjected to authentication by the repository, and the verification information being configured to signal to the user that the repository provides such authentication (Eden: paragraph 0034).

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27. Regarding claim 55, Eden further discloses wherein data stored in the memory cannot be altered by users (Eden: paragraph 0042).

28. Regarding claim 56, Eden further discloses including apparatus to receive the image data from a remote location (Eden: paragraph 0042).

29. Regarding claim 57, Eden further discloses including a scanner for scanning an original document to produce said image data (Eden: paragraph 0043).

30. Regarding claim 58, Eden further discloses including a repository agent including apparatus operable to send image data corresponding to an original image to the repository (Eden: paragraph 0049).

31. Regarding claim 59, Eden further discloses wherein the repository agent is operable to send the image data together with source authentication information to indicate to the repository that the image data has been sent from the agent (Eden: paragraph 0029).

32. Regarding claim 60, Eden further discloses wherein the verification information comprises predetermined accreditation indicia to be viewed by a user concurrently with the image data for authenticating individual parts of the original document (Eden: paragraph 0032).

33. Regarding claim 61, Eden further discloses wherein the verification information comprises accreditation data to be viewed by a user in a separate field associated with the image data for authenticating the original document (Eden: paragraph 0033).

34. Regarding claim 62, Eden further discloses wherein the image data and the verification information are stored in a common electronic file (Eden: paragraph 0019).

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35. Regarding claim 63, Eden further discloses wherein the file is a PDF file (Eden: paragraph 0019).

36. Regarding claim 64, Eden further discloses including a server providing said memory and operable to host a website at which said image data and verification information is viewable by a user to authenticate the original document (Eden: paragraph 0021).

37. Regarding claim 65, Eden further discloses wherein said output is connected to the Internet (Eden: paragraph 0028).

38. Regarding claim 66, Eden further discloses wherein said image data and verification information in the memory is password protected so that the user can only gain access thereto by use of the password (Eden: paragraph 0036).

39. Regarding claim 67, Eden further discloses wherein the image data and the verification information corresponding to the original document when stored in the memory collectively has an individual addressable identity (Eden: paragraph 0029).

40. Regarding claim 68, Eden further discloses to provide said image data and said verification information for display by the user to authenticate the original document (Eden: paragraph 0029).

41. Regarding claim 69, Eden discloses a method of displaying a document for authentication, comprising: creating electronic image data corresponding to an original document having a verifiable provenance, providing electronic, displayable verification information corresponding to the provenance of at least part of the original document,

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and displaying the image data and the verification information, to permit a user to authenticate the document (Eden: paragraphs 0028 and 0030).

42. Regarding claim 70, Eden further discloses including receiving the image data from an authenticated source, storing the image data for display, and creating the verification information for the received image, wherein the verification information includes data corresponding to the provenance of the authenticated source (Eden: paragraph 0032).

43. Regarding claim 71, Eden further discloses including authenticating the source of the image data (Eden: paragraphs 0028 and 0030).

44. Regarding claim 72, Eden further discloses including feeding the image data and the verification information to a memory under the control of a repository for display to users wishing to authenticate the original document (Eden: paragraphs 0028 and 0036).

45. Regarding claim 73, Eden further discloses wherein only the repository can change the data in the memory (Eden: paragraph 0036).

46. Regarding claim 74, Eden further discloses wherein the verification information comprises data concerning the provenance that has been authenticated by the repository (Eden: paragraphs 0036-0038).

47. Regarding claim 75, Eden further discloses wherein the repository communicates with the source of the image data to determine the provenance thereof and to develop said verification information (Eden: paragraph 0042).

48. Regarding claim 76, Eden further discloses including feeding the image data to the repository from a remote location (Eden: paragraph 0038).

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49. Regarding claim 77, Eden further discloses including sending send image data corresponding to an original image from a repository agent to the repository (Eden: paragraphs 0028 and 0036-0038).

50. Regarding claim 78, Eden further discloses including sending the image data together with source authentication information to indicate to the repository that the image data has been sent from the repository agent (Eden: paragraphs 0036-0038).

51. Regarding claim 79, Eden further discloses including configuring the verification information to include predetermined accreditation indicia viewable concurrently with the image data for authenticating individual parts of the original document by a user that authenticates the document (Eden: paragraphs 0028 and 0030).

52. Regarding claim 80, Eden further discloses including configuring the verification information to comprise accreditation data to be viewable by a user in a separate field associated with the image data for authenticating the original document (Eden: paragraphs 0028 and 0030).

53. Regarding claim 81, Eden further discloses including storing the image data and the verification information are stored in a common electronic file (Eden: paragraph 0049).

54. Regarding claim 82, Eden further discloses including storing the image data and the verification information are stored in a common electronic PDF file (Eden: paragraphs 0028 and 0030).

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55. Regarding claim 83, Eden further discloses including hosting a website at which said image data and verification information is viewable by a user to authenticate the original document (Eden: paragraphs 0028 and 0030).

56. Regarding claim 84, Eden further discloses including authenticating the original document by viewing said electronic image data and the corresponding verification information (Eden: paragraphs 0028 and 0030).

57. Regarding claim 85, Eden further discloses wherein said image data and verification information is password protected so that a user can only gain access thereto by use of the password, and including supplying the password to a user to permit the user to authenticate the original document (Eden: paragraph 0042).

58. Regarding claim 86, Eden further discloses wherein the image data and the verification information corresponding to the original document collectively have an individual addressable identity and including supplying the individual addressable identity to a user to permit the user to access the data and information for authenticating the original document (Eden: paragraphs 0028 and 0030).

59. Regarding claim 87, Eden further discloses including supplying a hyperlink to the user (Eden: paragraphs 0028-0029).

60. Regarding claim 88, Eden discloses an electrical signal for displaying a document for authentication to be received by a client computer operated by a user who wishes to authenticate the document, comprising: electronic image data corresponding to an original document having a verifiable provenance, and electronic, displayable

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verification information corresponding to the provenance of at least part of the original document (Eden: paragraphs 0028 and 0030).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRANG DOAN whose telephone number is (571)272-0740. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William R. Korzuch can be reached on (571) 272-7589. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Trang Doan/
Examiner, Art Unit 2431

/William R. Korzuch/
Supervisory Patent Examiner, Art Unit 2431